

REMARKS

The sections set forth below are presented in the same order as that of the Action for ease of reference.

The Specification

The title was objected to for not being descriptive. Consequently, the title has been changed to: "Displaying Option Information Using a Non-Modal Dialog Box". Support for this change can be found, for example, in claim 1. No new matter has been added. The applicant respectfully asserts that the amended title clearly indicates the invention to which the claims are directed.

In view of the above amendment and remarks, the applicant respectfully requests withdrawal of the objection to the title.

The Drawings

The drawings were objected to because cursor 18 was not shown in Fig. 5A.

Consequently, enclosed herewith for the Examiners' approval is a proposed correction of Fig. 5A that includes a cursor 18. A second copy of Fig. 5A marked in red ink has also been enclosed to show the change. Support for this amendment can be found on page 9, lines 21-22 of the application. No new matter has been added.

In view of the amendment to Fig. 5A, the applicant respectfully requests withdrawal of the objection to the drawings.

Claim Rejections under 35 U.S.C. 102(b)

Claims 1-6, 8-18 and 20-22 were rejected for allegedly being anticipated by Watson et al., U.S. Patent No. 5,912,666 ("Watson").

Independent claim 1 recites a method of displaying option information on a screen for use by a computer user. The method includes displaying a workspace on a computer screen, displaying at least one icon, presenting a non-modal dialog box within the workspace when a predetermined icon is chosen, providing a preference option that hides or shrinks the non-modal dialog box when a cursor moves off a frame of the dialog box, and providing at least one means for restoring the non-modal dialog box(emphasis added). Thus, the technique includes automatic dismissal of the non-modal dialog box when the user moves her cursor off of the frame. Independent claim 12 recites a computer program that similarly operates to hide or shrink a non-modal dialog box when a cursor is moved outside the boundaries of the

non-modal dialog box. Consequently, the user does not have to click on any command boxes (which minimizes mouse use) or perform any special key combinations to dismiss the non-modal dialog box. This is advantageous because automatic dismissal of the non-modal dialog box maximizes the amount of computer screen real estate space usable to display work, while still preserving a full range of options for conducting operations. Furthermore, and most importantly, this feature permits more time to be devoted to actually working on the drawing project rather than spending time on calling up, moving and/or dismissing dialog boxes. (See application, page 4, lines 3-10).

In contrast, Watson pertains to an object-oriented global cursor tool. Fig. 8 of Watson illustrates a desktop with various frames. In Fig. 8 a user has two documents open, wherein one document 800 is active, and the other document 810 is inactive. Both documents have two frames, one "PinkDraw" frame and one "Text" frame as shown, and the user is choosing tools from PinkDraw's command panel 830 (see Watson, col.10, line 63 to col. 11, line 1). There is no teaching or suggestion of a non-modal dialog box that can be automatically dismissed when a cursor moves off of the frame of the non-modal dialog box as required in independent claims 1 and 12. Since such operation is absent in the system disclosed in Watson, claims 1 and 12 are not anticipated.

In view of the above remarks, the applicant respectfully requests withdrawal of the 35 U.S.C. 102(b) rejections of independent claims 1 and 12. In addition, claims 2-6, 8-11, 13-18 and 20-22 all directly or indirectly depend on either claim 1 or claim 12, and thus should also be allowable for at least the same reasons.

Claim Rejections under 35 U.S.C. 103

Dependent claims 7 and 19 were rejected for allegedly being unpatentable over Watson in view of Screen Dumps of Microsoft Word 2000 ("MS Word").

As best understood, the MS Word screen dump purportedly illustrates that a key combination can be used to shrink a dialog box, and a restore action occurs if the same key combination is repeated. However, there does not appear to be any teaching of such operation in the figures provided. But even if such teaching were apparent, there is no suggestion or teaching to combine the Watson patent with the MS Word screen dump. Thus, the applicant traverses this rejection because it is a hindsight rejection, using applicant's claim as a template to reconstruct the invention by picking and choosing isolated disclosures from the prior art. This is impermissible under the law. For example, in *in re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600)

The present rejection fits the court's description of what may not be done under § 103. The examiner has merely listed certain components of applicant's invention and then located isolated disclosures of those components. The law requires more than that.

The examiner must show where the prior art provides a motivation to combine the references she has combined in the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As the Federal Circuit stated in *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990):

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

The applicant thus respectfully asserts that obviousness has not been demonstrated.

Furthermore, claims 7 and 19 indirectly depend upon independent claims 1 and 12, which are patentably distinct over the cited art as explained above. In particular, the cited Watson patent or the MS Word screen dump, alone or in combination, does not suggest or teach to hide or shrink a non-modal dialog box when the cursor is moved outside the boundaries of the non-modal dialog box. Thus, claims 7 and 19 should be allowable for at least the same reasons as claims 1 and 12.

In view of the above remarks, the applicant respectfully requests withdrawal of the 35 U.S.C. 103 rejections of claims 7 and 19.

An executed Revocation and Power of Attorney by Assignees is enclosed. Please direct all future correspondence to Customer No. 28765 to the attention of the undersigned.

No fee is believed to be due for this amendment, but if there is a fee deficiency please charge Winston & Strawn Deposit Account No. 501-814.

In view of the above amendments and remarks, the applicant respectfully requests favorable reconsideration and allowance of all of the pending claims of the application.

Respectfully submitted,

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